

REMARKS:

Claims 1-20 and 27-30 are pending in this application. By this amendment, claim 5 is cancelled, claims 1, 4, 6, 7, 16, and 28 are amended. No new matter is added. Support for the amended or the new claims is provided within the specification and the claims as filed.

Applicant is not conceding that the subject matter recited in the amended or canceled claims prior to this Amendment is not patentable over the art cited by the Examiner. The amended or cancelled claims in this Amendment are provided solely to facilitate expeditious prosecution of the allowable subject matter noted by the Examiner. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by the amended or cancelled claims as presented prior to this Amendment and additional claims in one or more continuing applications.

Claim of Priority

Applicant notes that the Office Action lacks the acknowledgement of the Applicant's claim of foreign priority under 35 U.S.C. § 119(a). We note none of the boxes were marked on the Office Summary page. Please let us know if all, some or none of the copies have been received.

§112 Rejection

Claims 16-20 are rejected under 35 U.S.C. §112, second paragraph due to typographical errors. The claims have been amended to rectify the noted deficiencies. The 112 grounds of rejection is now moot.

§101 Rejection

Claims 1-15, 27 and 30 are rejected under 35 U.S.C. §101. The Examiner contends that the claimed invention is directed to non-statutory subject matter. The Applicant respectfully traverse this rejection in light of the current amendments.

Claims 1 and 28 as amended recite a base station, and amended claim 16 recites a mobile station. Therefore, claims 1, 16, and 28 are tied to a specific machine or apparatus, i.e., a base station or a mobile station. Moreover, the applicant believes that allowance of claims 1 and 28 does not allow the applicant to substantially pre-empt all uses of the fundamental principle recited in these claims, because such principles may be implemented in non-wireless communication systems. The subject matter of claims 1, 16, and 28 falls within preview of patentable processes under the statute. Therefore, withdrawal of this rejection is respectfully requested.

§102 Rejection

Claims 1-20 and 27-30 are rejected under U.S.C. 102(e) as being anticipated by Cooper et al (PGPUB 2004/0236849) (hereinafter “Cooper”). This rejection is respectfully traversed as follows.

It is respectfully noted that anticipation of a claim under 35 U.S.C. §102 (a), (b) and (e) requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim" and "[t]he elements must be arranged as required by the claim." MPEP §2131. In addition, anticipation of claims using a drawing requires that "the picture must show all the claimed structural features and how they are put together" and "[t]he drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art." MPEP §2125.

Claims 1, 16, and 28 as amended recite receiving or transmitting a 15-digit International Mobile Station Identity (IMSI) generated from a IMSI having fewer than 15 digits by adding padding bits to the IMSI having fewer than 15 digits. The amendment is supported at least by paragraphs [0044], [0045], and [0076] of the originally filed specification. The recited feature is not disclosed by Cooper.

Cooper teaches that only two digits of the 3-digit NOC value are carried in the IMSI_11_12 field. Cooper fails to disclose or suggest, however, the location in which the remaining one digit of the 3-digit NOC value is carried in. The Examiner contends that “if the NOC is 3-digits, it is carried in the IMSI_11_12 and in the least significant digit [bit] of the MCC as presented by nnA”. The applicant presumes that the Examiner assertion is based on the following sentences in Cooper:

“The 3-digit NOC may be represented as nnA, where A is a fixed 1-digit value (e.g., A=0) for the least significant digit of the MCC and nn is a 2-digit value ranging from 0 through 99 for the two most significant digits of the MCC. The IMSI_11_12 field may then be set to nn.” (see paragraph [0037] of Cooper)

Please note that the first sentence does not literally state that A is carried in the least significant digit of the MCC, but only state “A is … for the least significant digit of the MCC”.

There is no teaching, however, that A is carried in the least significant digit of the MCC because of the following reasons:

(1) The first one of the cited sentences states “The 3-digit NOC may be represented as nnA” but also states “where A is … for … the MCC and nn is … for … the MCC”. If read within contest, Cooper suggests that ‘nnA’ is not for the MCC but for the 3-digit NOC. Therefore, it is concluded that the first sentence is not self-explanatory and thus cannot be used as a rejection ground.

(2) The Examiner suggests that “if the NOC is a 3-digits, it is carried in the IMSI_11_12 and in the least significant digit [bit] of the MCC as presented by nnA”. From the statement “it is carried in the IMSI_11_12”, the Examiner seems to admit the second sentence as it is, and from the statement “it is carried … in the least significant digit [bit] of the MCC as presented by nnA”, the Examiner also seems to admit the first sentence as it is.

Accordingly, the applicant believes that it should be also admitted that ‘nn’ is carried in both IMSI_11_12 and the two most significant digits of the MCC. This means that the IMSI_11_12 and the two most significant digits of the MCC indicate the same field because it is clear that Cooper intended that nn is carried in a specific field, specifically IMSI_11_12. But it is contrary to logic because Cooper clearly defined the MCC and the IMSI_11_12 as different entities in the disclosure. Also, it is noteworthy that, if the least significant digit of the MCC is used to carry one digit of the 3-digits NOC such that the MCC gives its place to the 3-digit NOC, the MCC cannot play its own role. Therefore, the applicant concluded that

the first sentence has certain logical mistakes or typographical errors, and again should not be used as a rejection ground.

For these reasons, we believe that the first sentence can be rewritten as follows to correct the typographical errors:

“The 3-digit NOC may be represented as nnA, where A is a fixed 1-digit value (e.g., A=0) for the least significant digit of the NOC and nn is a 2-digit value ranging from 0 through 99 for the two most significant digits of the NOC”.

From the above discussion, it is shown that there is no explicit statements or suggestion in the disclosure of Cooper indicating that A is carried in the least significant digit of the MCC. Further, specific fields or locations to carry the remaining one digit of the 3-digit NOC value are not defined in Cooper. Therefore, Cooper does not disclose the feature corresponding to “a second field comprising a least significant digit of the MNC” as claimed in claim 1.

The Examiner at page 10 of the Office Action contends that “one could undeniably conclude that Cooper … does indeed teach the field in the message indicates that the MNC has a first length or a second length as argued by the Applicants.” The applicant respectfully disagrees the literal teaching of Cooper only reveals that there is a *need* to define a certain field in the message to indicate that the MNC has a first length or a second length.

In conclusion, because claims 1, 16, and 28 recite a field comprising a least significant digit of a MNC, and transmitting or receiving a 15-digit IMSI generated from a IMSI having fewer than 15-digits, and such recited elements are not disclosed in Cooper, claims 1, 16, and 28 and their dependent claims are patentably distinguishable over Cooper.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623 2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,
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